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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,269	10/20/2003	Triveni P. Shukla	00030-001	2927

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EXAMINER	
DONOVAN, MAUREEN C	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/689,269	SHUKLA ET AL.	
	Examiner	Art Unit	
	Maureen C. Donovan	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-6 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to communications: Amendment A, filed 22 December 2004.
2. Claims 1-6 are pending.

Specification

1. Applicant indicates in the arguments filed 22 December 2004that US patent number 5,766,622 was incorporated by reference in the original as-filed application. The attempt to incorporate subject matter into this application by reference to US patent number 5,766,622 is however improper because mere reference to another application, patent or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C 112, first paragraph. *In re de Seversky,* 474 F.2d 671, 177 USPQ 144 (CCPA 1973).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGinley, US Patent number 5,192,569 in view of Inglett, US patent number 5,766,662. The reference and rejection are incorporated as cited against claims 1-6 in the previous Office action mailed 22 September 2004.

Response to Arguments

Applicant's arguments filed 22 December 2004 have been fully considered but they are not persuasive. At page 5 of the response, applicant states that the dietary fiber of McGinley in view of Inglett does not meet the limitations of the instant invention by not being amorphous, non-particulate, non-coated, insoluble or derived from the alkaline treatment of agricultural by-

products. At page 6 of the response the applicant states that McGinley in view of Inglett is directed to a non-liquid fat substitute. At page 6 of the response the applicant states that Inglett does not suggest that meats could contain a liquid fat substitute. Applicant also states on page 10 of the response that the lipid of McGinley is not the same as the lipid as instantly claimed which is a fat and oil component. This is not deemed persuasive.

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the dietary fiber be amorphous, non-particulate, non-coated, insoluble and derived from the alkaline treatment of agricultural by-products) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that McGinley in view of Inglett is directed to a non-liquid fat substitute, it is submitted that McGinley teaches a product having liquid properties. McGinley teaches the use of the product in an aqueous dispersion (see McGinley Column 7, lines 59-63). The obviousness rejection was made regarding the obviousness of using the product of McGinley, which is a liquid (see McGinley Column 7, lines 59-63), in a meat product as taught by Inglett. The rejection therefore does not rely on the physical state of the Inglett product and since McGinley teaches a liquid product, the rejection does encompass a liquid fat substitute product.

In response to applicant's argument that Inglett does not suggest that meats could contain a liquid fat substitute, it is submitted that Inglett teaches the use of a gel product in a meat (see Inglett, Column 5, lines 5-15). A gel is a combination of a liquid and a finely dispersed solid. The applicant claims a liquid shortening that comprises a gel, therefore the "liquid" as instantly claims would also be a contain of a finely dispersed solids and liquids, and is not entirely a liquid. Therefore it is submitted that Inglett's teaching of a gel, does teach the use of a product with a liquid in a meat.

In response to applicant's argument that the lipid of McGinley is not the same as the lipid as instantly claimed, it is submitted that the lipid of McGinley is interpreted to be a fat and oil component (see McGinley, Column 4, lines 45-54), as the difference is not apparent between a

lipid used to impart flavor and one that is a component, since a lipid used as a component only requires the presence of the lipid, which a lipid used as a flavorant would satisfy.

Response to Amendment

3. The amendment filed 22 December 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The sentences, which were added to the disclosure in the response filed 22 December 2004, that begin with:

"The dietary fiber gels are produced" , "Dietary fiber gels in a hydrated form"

and

"A physically smooth morphology"

These sentences introduce new matter regarding the production of the dietary fiber, its morphology and its physical state. Although applicant states that this matter can be added from US patent number 5,766,662; as noted above, US patent number 5,766,622 is not viewed to be incorporated by reference and therefore these amendments do introduce new matter.

Additionally, the sentence beginning "Without being bound..." that was added to the disclosure in the response filed 22 December 2004 is also new matter. This sentence introduces theories based on the information presented in US patent number 5,766,662. Since this sentence introduces information that is not present in US patent number 5,766,662, even if this patent is properly incorporated, this sentence would still be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/689267 in view of McGinley and Inglett. The reference and rejection are incorporated as cited against claims 1-6 in the previous Office action mailed 22 September 2004. This is a provisional obviousness-type double patenting rejection.

Applicant's arguments filed 22 December 2004 have been fully considered but they are not persuasive. At page 12 of the response, applicant states that Application No. 10/689267 in view of McGinley and Inglett does not teach meats comprising emulsified liquid shortening with a dietary fiber gel that is non-coated and non-particulate and a lipid that is a fat and oil component, wherein the fiber is produced via the alkaline treatment of agricultural by-products. This is not deemed persuasive. Applicant recognizes the fact that Application No. 10/689267 in view of McGinley teaches processed meats comprising a coated dietary fiber and a lipid (see page 12, lines 8-18). Since McGinley in view of Inglett does teach the fat substitute in a liquid form, and since the lipid of McGinley in view of Inglett is not viewed as different from a fat and oil component, all as shown in the response to arguments section above; the scope of the recognized teachings of Application No. 10/689267 in view of McGinley and Inglett encompasses the invention as instantly claimed. Applicant's arguments that the instantly claimed invention is directed to dietary fibers that are amorphous, non-coated, non- particulate or insoluble and produced via the alkaline treatment of agricultural by-products are not deemed persuasive as those limitation are not found in the claim language, and as stated above, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1 181, 26 USPQZd 1057 (Fed. Cir. 1993).

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen C. Donovan whose telephone number is (571) 272-2739. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCD

KEITH HENDRICKS
PRIMARY EXAMINER